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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/758,648	01/10/2001	Larry Lunetta	004565.P001	9518
21186	7590	10/05/2005	EXAMINER	
SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH 1600 TCF TOWER 121 SOUTH EIGHT STREET MINNEAPOLIS, MN 55402			PATEL, KANJIBHAI B	
			ART UNIT	PAPER NUMBER
			2625	

DATE MAILED: 10/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/758,648

Applicant(s)

LUNETTA ET AL.

Examiner

Kanji Patel

Art Unit

2625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5, 16-25, 32-38, 42-46, 50-52, 55-59, 62 and 63 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5, 16-25, 32-38, 42-46, 50-52, 55-59, 62-63 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>7/11/05</u> . | 6) <input type="checkbox"/> Other: _____  |

***Response to Amendment***

1. Applicant's amendment filed on 7/11/05 has been entered and made of record.

**Claims 1-5, 16-25, 32-38, 42-46, 50-52, 55-59 and 62-63** are pending in the application.

***Response to Arguments***

2. Applicant's arguments, see pages 10-11 of the remarks, filed 7/11/05, with respect to the Double Patenting Rejection of claim(s) 1-5, 16-25, 32-38, 42-46, 50-52, 55-59 and 62-63 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of the Berger et al. (US 6,414,693 B1; already on record -- IDS)

***Information Disclosure Statement***

3. Information Disclosure submitted on 7/11/05 has been considered by the examiner.

4. ***Claim Rejections - 35 USC § 102***

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 1-5, 16-25, 32-38, 42-46, 50-52, 55-59 and 62-63** are rejected under 35 U.S.C. 102(e) as being anticipated by Berger et al. (hereinafter referred to as Berger) (US 6,414,693 B1).

**For claim 1**, Berger discloses a method for generating a composite image including (at least figure 1):

presenting a first image (at least 702 in figures 7-8 represents a first image; column 2, lines 26-27; bags, luggage, totes, portfolios can provide a first image) via a web interface (104, 106, 108 provide a router providing a web interface) presented on a browser (clients 110, 112 in figure 1 provide web browsers);

presenting a second image (at least 704 in figures 7-8 corresponds to a second image; column 2, line 28; graphics images like logos, trade names, photographs can provide a second image) via a web interface presented on the browser;

communicating (column 2 line 66 to column 3 line 8; cloud 102 in figure 1 is used for communication between server and clients) a selection (column 6, lines 48-55; column 5, lines 50-59) of the first image (602, 702) and the second image (608, 704) to a server (116) via a network (100);

automatically generating a composite image ( Figure 4; using Drag and Drop function of the mouse will generate a composite image; for example 702 in figure 9 is a composite image) of the first image and the second image at the server (116); and

communicating (102, 104, 106, 108) the composite image (702 in figure 9) from the server (116) to the browser (110, 112) via the network (100).

**For claims 2, 22, 35, 43, 51, 58**, Berger discloses the method wherein the first image is a product image (at least bag in figures 7-8 is a product image).

**For claims 3, 23, 36, 44, 52 and 59,** Berger discloses the method wherein the second image is a decorative image including any one of a group of images including a logo image and a text image (704 in figures 7-8, corresponds to a decorative image).

**For claims 4, 24, 37 and 45,** Berger discloses the method wherein the composite image includes the second image placed in a default position on the first image (802, 902 in figure 9).

**For claims 5 and 25,** Berger discloses the method further including:

- positioning the second image (column 4, lines 43-62; see also figures 6-7; column 7, lines 44-57; double arrow 902 is used to position horizontally and arrow 904 is used to position vertically) relative to the first image (702 in Figures 7-8) presented on the browser to generate relative positioning information;
- communicating (102, 104, 106, 108) the relative positioning (column 7, lines 44-57) information to the server (116) via the network (100);
- automatically generating the composite image (702 in figure 9 is a composite image) of the first image (702 in figures 7-8) and the second image (704) at the server (116) according to the relative positioning information (figure 9).

**For claim 16 and 32,** Berger discloses the method wherein the composite image (702 in figure 9) is associated with information in a database (122 in figure 1 is a database), the associated information in the database being communicated together with the composite image from the server (116) to the browser (110, 112) via the network (102, 104, 106, 108) as a photo sample (figure 9).

**For claims 17 and 33,** Berger discloses the method wherein the photo sample is sent via network to a specified e-mail address (column 8, lines 13-20).

**For claim 18,** Berger discloses the method wherein a URL containing the photo sample is sent via network to a specified e-mail address (column 8, lines 13-20; column 4, lines 30-42).

**For claim 19,** Berger discloses the method wherein a user zooms (column 7, lines 13-15) in to the photo sample.

**For claim 20,** Berger discloses the method wherein a user zooms out of the photo sample (column 7, lines 13-15).

**For claim 21,** see the rejection of claim 1 above.

**For claim 34,** Berger discloses a network-based method for generating a composite image, the method including:

presenting a first image (at least 702 in figures 7-8 represents a first image; column 2, lines 26-27; bags, luggage, totes, portfolios can provide a first image; 602) for user selection (column 6, lines 48-55; column 5, lines 50-59) via a first Web interface presented on a browser 110);

uploading a second image (at least in Figure 6, by clicking button 608 a second image of logo image uploaded to composite with the first image of bag);

communicating (102, 104, 106, 108 are used for communication) a selection (column 6, lines 48-55; column 5, lines 50-59) of the first image and the second image to a server (116) via a network (100);

displaying the composite image via a second web interface presented on the browser (at least Figure 9).

**For claims 38 and 46,** see at least the rejection of claim 5 above.

**For claim 42,** see the rejection of at least claims 1 and 34 above.

**For claim 50, Berger** discloses an apparatus for generating a composite image (Figures 1, 9) including:

a first image database (122; column 3, lines 37-43), the first image database to store at least one first image file (column 2 line 59 to column 4 line 29);

a second image database (122; column 3, lines 37-43), said second image database to store at least one second image file (Figure 2);

a server (116) to receive a user selection (column 6, lines 48-55; column 5, lines 50-59) of the first image file and the second image file and to generate a composite image (Figure 9) of a first image and a second image wherein the second image is positioned relative to the first image.

**For claims 55 and 62,** Berger discloses the apparatus wherein the server (116) is further configured to generate a photo sample (figure 9).

**For claims 56 and 63,** Berger discloses the apparatus wherein the server (116) is further configured to transmit the photo sample via the network (102) to a specified e-mail address (column 8, lines 13-20).

**For claim 57,** see the rejection of claim 42 above.

### **Contact Information**

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kanji Patel whose telephone number is (571) 272-7454. The examiner can normally be reached on Monday to Friday from 8:00 a.m. to 4:30 p.m. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bhavesh Mehta, can be reached on (571) 272-7453. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Kanji Patel  
Art Unit 2625  
9/30/05

  
**KANJIBHAI PATEL**  
**PRIMARY EXAMINER**